

REMARKS

This is in full and timely response to the above-identified Office Action. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

- 1) The rejection of claims 1 and 3-11 under 35 USC § 112, first paragraph is respectfully traversed.

An inspection of the claims submitted in the response filed on September 15, 2004 reveals that the units which are set forth in connection with the range of 0.25-0.75 are in fact "μm" and not "mm." The source of this rejection is not fully understood and reconsideration is respectfully requested.

- 2) The rejection of claims 1, 6 and 9-12 under 35 USC § 102(b) as being anticipated by Konushi et al. (JP 10-335179), is respectfully traversed.

It is submitted that the PTO's interpretation of the disclosure Konushi et al. (JP 10-335179) (and that of Konushi et al. (USP 6,104,597) is incorrect. This rejection is based on the position that Konushi et al. (JP 10-335179) discloses  $\text{Ba}_{1-x}\text{Sr}_x\text{TiO}_3$  ( $0 \leq x \leq 1$ ). This is incorrect. In fact, the translation which has been provided with Konushi et al. (JP 10-335179) is also incorrect/misleading. More specifically, paragraph [0036] which is relied on in the rejection, discloses:

"... In addition, the perovskite mold multiple oxide crystal containing Ba(s) and Ti other than the dielectric thin film which consists of a perovskite mold multiple oxide crystal which contains Pb, Mg, and Nb in this invention, PZT, PLZT, SrTiO<sub>3</sub> and Ta<sub>2</sub>O<sub>5</sub> grade are sufficient, and it is not limited especially."

However, what is, in fact, disclosed in the Japanese reference is:

Note, in accordance with this invention, there is no special limitation on the use of Pb, Mg, Nb including perovskite composite oxide crystals, and that, for example, Ba, Ti including perovskite composite oxide crystals, PZT, PLZT,  $\text{SrTiO}_3$  or  $\text{Ta}_2\text{O}_5$  are also particularly good.

Thus, what is disclosed is , Ba, Ti including perovskite composite oxide crystals or PZT or PLZT or  $\text{SrTiO}_3$  or  $\text{Ta}_2\text{O}_5$  are also particularly good. In other words, only the perovskite composite oxide crystals are disclosed as “including” Ba, or Ti.

In addition, attention is called to the fact that Konushi et al. (USP 6,104,597) claims Konushi et al. (JP 10-335179) as one of the three priority documents on which it is based. Konushi et al. (USP 6,104,597) correctly discloses at column 5, lines 62-64, that:

It is also allowable to form a dielectric layer 1 by using perovskite-type composite oxide crystals containing Ba and Ti, **or by using** PZT, PLZT,  $\text{SrTiO}_3$  or  $\text{Ta}_2\text{O}_3$ .  
(Emphasis added)

In conclusion, it is submitted that neither Konushi et al. (JP 10-335179) nor Konushi et al. (USP 6,104,597) clearly and unambiguously disclose the use of the claimed  $\text{Ba}_{1-x}\text{Sr}_x\text{TiO}_3$  ( $0 \leq x \leq 1$ ) material. Indeed, what is disclosed in these documents is that Ba and Ti containing perovskite composite oxide crystals or PZT or PLZT or  $\text{SrTiO}_3$  or  $\text{Ta}_2\text{O}_3$ , can be used. This does not establish a *prima facie* case of anticipation.

- 3) The rejection of claims 1 and 3-5 and 8 under 35 USC § 102(b) as being anticipated by Konushi et al (USP 6,104,597), is respectfully traversed.

As noted above, column 5, lines 60-67 does not disclose the use of  $\text{Ba}_{1-x}\text{Sr}_x\text{TiO}_3$  ( $0 \leq x \leq 1$ ) and instead discloses composite oxide crystals which include Ba, or Ti, but nothing more. The claimed subject matter is therefore not disclosed and the rejection is untenable.

- 4) The rejection of claim 7 under 35 USC § 103(a) as being unpatentable over Konushi et al (USP 6,104,597) in view of Klee et al. (USP 6,125,027) is respectfully traversed.

This rejection falls with the anticipation rejection of claim 1.

Conclusion

Applicant submits that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that this would expedite the resolution of any remaining issues and advance the prosecution of the present application.

Respectfully submitted,

By 

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TRANSLATION CERTIFICATION

I hereby declare that I, Keith John Townsend, am conversant with both English and Japanese and that the sentence which spans lines 38-44, of column 5 (page 4) of Japanese Patent Publication 10-335179, reads as follows:

Note, in accordance with this invention, there is no special limitation on the use of Pb, Mg, Nb including perovskite composite oxide crystals, and that, for example, Ba, Ti including perovskite composite oxide crystals, PZT, PLZT,  $\text{SrTiO}_3$  or  $\text{Ta}_2\text{O}_5$  are also particularly good.



Keith J. Townsend